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**REMARKS**

Claims 1, 3-8, 10-15, and 17-20 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1). As will be shown below, neither Akhteruzzaman nor Hirschberg, either alone or in combination, teaches or suggests a method, system, or computer program product for voicemail searching as claimed in the present application. Claims 1, 3-8, 10-15, and 17-20 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1, 3-8, 10-15, and 17-20.

Claims 2, 9, and 16 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1) further in view of Yuschik, *et al.* (U.S. Publication No. 20020152078A1). As will be shown below the combination of Akhteruzzaman, Hirschberg, and Yuschik does not teach or suggests a method, system, or computer program product for voicemail searching as claimed in the present application. Claims 2, 9, and 16 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 2, 9, and 16.

**Claim Rejections – 35 U.S.C. §103**

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103

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is that the proposed combination of references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Akhteruzzaman And Hirschberg

Claims 1, 3-8, 10-15, and 17-20 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1). As will be shown below, the proposed combination of Akhteruzzaman and Hirschberg cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination of Akhteruzzaman and Hirschberg. The combination of Akhteruzzaman and Hirschberg therefore does not establish a prima facie case of obviousness. The rejection of claims 1, 3-8, 10-15, and 17-20 should therefore be withdrawn and the case should be allowed.

The Combination Of Akhteruzzaman And Hirschberg Does Not Teach or Suggest All Claim Limitations Of Claim 8

The proposed combination of Akhteruzzaman and Hirschberg cannot establish a prima facie case of obviousness. To establish a prima facie case of obviousness, the proposed combination of Akhteruzzaman and Hirschberg must disclose or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Independent claim 8 of the present applications claims:

8. A system for voicemail searching, the system comprising:

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means for storing, in association with a voicemail message, a voiceprint of a caller;

means for storing at least one caller speech tag in association with the voiceprint;

means for identifying, in dependence upon the voiceprint, a caller who leaves a voicemail message;

means for receiving, from a particular voicemail user, at least one search keyword; and

means for selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user.

Akhteruzzaman

Regarding the rejection of claim 8 of the present application, the Office Action at page 2 states:

Akhteruzzaman's system comprises voice message system 102 for storing a voicemail message in which at least a portion of the stored voice message is speech characteristic of a calling party [Page 3, see Step 304, 305 & 306 in Paragraph 0017] (speech characteristic of a calling party reads on a voiceprint of a calling party and voice message system 10 reads on means for storing a voicemail message in association with a voiceprint of a calling party)....

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That is, this portion of the Office Action takes the position that steps 304, 305, and 306 in paragraph 0017 of Akhteruzzaman teach the first element of independent claim 8 in the present application. What paragraph 0017 of Akhteruzzaman actually teaches is:

the subscriber at step 304 leaves a voice message for the subscriber and hangs up. At step 305, the processor 114F activates the speech analysis system 114A of the voice-print based voice message screening system 114 to retrieve at least a portion of the voice message stored by the calling party and determines, at step 306, the speech characteristics of the calling party.

That is, the speech analysis system of Akhteruzzaman determines speech characteristics of a caller based on a portion of the voice message. Determining speech characteristics of a caller is not storing, in association with a voicemail message, a voiceprint of a caller as claimed in the present application. Akhteruzzaman's speech analysis system that determines speech characteristics of a caller based on a portion of the voice message therefore does not teach a means for storing, in association with a voicemail message, a voiceprint of a caller as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

Further regarding the rejection of claim 8, the Office Action at page 2 states:

memory 114c for storing calling party tag in conjunction with speech characteristic of calling party (reads on means for storing at least one calling party speech tag in association with the voiceprint) [See step 211 in Paragraph 0015]....

This portion of the Office Action takes the position that step 211 in paragraph 0015 of Akhteruzzaman teaches the second element of independent claim 8 in the present

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application. What paragraph 0015 of Akhteruzzaman actually teaches is a speech analysis system that:

retrieves at least a portion of the voice message to determine, at step 211, the speech characteristics of the calling party, which are stored in memory 114C in conjunction with the calling party tag.

That is, the speech analysis system of Akhteruzzaman stores speech characteristics of a caller with a calling party tag. Claim 8 claims a means for storing at least one caller speech tag in association with the voiceprint. The speech characteristics of Akhteruzzaman are not voiceprints as claimed in the present application.

Akhteruzzaman's speech analysis system that stores speech characteristics of a caller with a calling party tag therefore does not teach a means for storing at least one caller speech tag in association with the voiceprint as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

Regarding the rejection of claim 8, the Office Action at pages 2 and 3 also states:

speech analysis system 114A & voice recognition system 114B for identifying a calling party who leaves a voice mail message based on the speech characteristic of the calling party (speech analysis system 114A & voice recognition system 114B reads on means for identifying a calling party who leaves a voicemail message, in dependence upon the voiceprint).

This portion of the Office Action takes the position that 'speech analysis system 114A' and 'voice recognition system 114B' of Akhteruzzaman teach the third element of independent claim 8 in the present application. What reference 114A of Akhteruzzaman actually teaches is a speech analysis system that "retrieves at least a portion of the voice

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message to determine, at step 211, the speech characteristics of the calling party...."

What reference 114B of Akhteruzzaman actually teaches is:

The voice recognition system 114B of the voice-print based voice message screening system 114 at step 307 attempts to compare the speech characteristics of the calling party, as determined by the speech analysis system 114A, with the sets of stored speech characteristics that are stored in memory 114C for calling parties that have been identified by the subscriber.

That is, the speech analysis system 114A and voice recognition system 114B of Akhteruzzaman compare the speech characteristics of a caller with a set of stored speech characteristics. Claim 8 claims a means for identifying, in dependence upon the voiceprint, a caller who leaves a voicemail message. The speech characteristics of Akhteruzzaman are not voiceprints as claimed in the present application. The speech analysis system 114A and voice recognition system 114B of Akhteruzzaman therefore do not teach a means for identifying, in dependence upon the voiceprint, a caller who leaves a voicemail message as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

Further still regarding the rejection of claim 8, the Office Action at page 3 states:

Akhteruzzaman also discloses that the user can screen [select] a received voice mail message which has been identified by the calling party speech tag [See Step 307 in Paragraph 0017] [See Step 308 on Paragraph 0018]. In other words, Akhteruzzaman teaches selecting a voice message based on the calling party speech tag.

This portion of the Office Action takes the position that step 307 in paragraph 0017 and step 308 in paragraph 0018 of Akhteruzzaman teach the fifth element of independent

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claim 8 in the present application. What step 307 in paragraph 0017 of Akhteruzzaman actually teaches is:

at step 307 the processor 114F of the voice-print based voice message screening system 114 associates the calling party tag that has been stored in memory 114C by the subscriber for this calling party with the voice message.

What step 308 in paragraph 0018 of Akhteruzzaman actually teaches is:

When the subscriber later activates the voice message system 102 to retrieve the voice message left by the calling party at step 308, the subscriber is provided with data indicative of the identity of the calling party.

That is, steps 307 and 308 of Akhteruzzaman associate a calling party tag with the voice message and provide a subscriber identity data of the calling party. Claim 8 claims means for selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user. Akhteruzzaman's associating a calling party tag with the voice message and providing a subscriber identity data of the calling party is not selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages. In fact, steps 307 and 308 of Akhteruzzaman never even once mention "selecting" or selecting based on a "search keyword." The system of Akhteruzzaman that associates a calling party tag with the voice message and provides a subscriber identity data of the calling party does not teach a means for selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

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Hirschberg

Further still regarding the rejection of claim 8, the Office Action at page 3 states:

Hirschberg discloses an entity extraction component of voice mail processor 30 [Figure 3] that allows the user to extract the user-specified information summarization of the voice mail message [Paragraph 0021, Line 4-8] [Paragraph 0022, Line 3-6] to expedite text searching in the messages [Paragraph 0006, Line 5-7] [Paragraph 0021, Line 3] [Paragraph 0027] [Paragraph 0034 & 0035] (text searching reads on selecting a voice message by a searched keyword and the user-specified information summarization of the voice mail messages reads on storing at least one caller tag in association with the voice mail messages).

This portion of the Office Action takes the position that paragraphs 0021 and 0022 of Hirschberg teach “storing at least one caller tag in association with the voice mail messages,” which Applicants take as a reference to “storing at least one caller speech tag in association with the voiceprint...” of claim 8 in the present application. What paragraph 0021 of Hirschberg actually teaches is that:

Entity extraction component 40 may further operate on transcribed text 48, step 94. Additionally, summarization component 38 may be used to perform concept, phrase, action item, keyword or other user-specified information summarization of the voicemail message(s), step 96.

What paragraph 0022 of Hirschberg actually teaches is that “summarization will be employed to identify information not retrieved through entity extraction such as certain concepts, topics, cue phrases, etc.” That is, paragraphs 0021 and 0022 of Hirschberg describe an extraction system that summarizes a voicemail. The extraction system of Hirschberg that summarizes a voicemail does not teach a means for storing at least one

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caller speech tag in association with the voiceprint as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

The above cited portion of the Office Action also takes the position that paragraphs 0006, 0021, 0027, 0034, and 0035 teach "selecting a voice message by a searched keyword," which Applicants take as a reference to "selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user" of claim 8 in the present application. Paragraphs 0006, 0021, and 0027 of Hirschberg teach a system that transcribes a voicemail into text. Paragraphs 0034 and 0035 of Hirschberg teach a system that allows a user to perform text queries on the transcribed voicemail. The system of Hirschberg that transcribes a voicemail into text and allows a user to perform text queries on the transcribed voicemail does not teach a means for selecting, in dependence upon the search keyword and the caller speech tag, one or more voicemail messages for the particular voicemail user as claimed in the present application. Because the Office Action does not teach each and every element of independent claim 8, the rejection should be withdrawn.

Regarding the rejection of claim 8, Applicants respectfully note that the Office Action does not cite the combination of Akhteruzzaman and Hirschberg for teaching a "means for receiving, from a particular voicemail user, at least one search keyword..." as claimed in claim 8 of the present application. The Office Action therefore does not teach each and every element of independent claim 8. Without more, the Office Action does not establish a *prima facie* case of obviousness, and the rejection should be withdrawn.

The Combination Of Akhteruzzaman And Hirschberg  
Does Not Teach or Suggest All Claim Limitations Of Claim 13

The Office Action at page 5 rejects independent claim 13 stating that, "Claim 13 is rejected for the same reason stated above in Claims 8 rejection because the claim's means substantially read on the corresponding means of Claim 8." In response, Applicants

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respectfully note that independent claim 13 does not claim the same subject matter as independent claim 8. Claim 13 of the present invention claims:

13. A system for voicemail searching, the system comprising:

means for storing, in association with a voicemail message, caller identification data that identifies a caller;

means for identifying, in dependence upon the caller identification data, a caller who leaves a new voicemail message;

means for receiving at least one search keyword from a particular voicemail user; and

means for selecting, in dependence upon the search keyword and the caller identification data, one or more voicemail messages for the particular voicemail user.

The system for voicemail searching of claim 13 is different from the system for voicemail searching of claim 8. Claim 13 claims means for storing caller identification data; claim 8 claims means for storing a voiceprint. Claim 13 claims means for selecting voicemail messages in dependence upon caller identification data; claim 8 claims means for selecting voicemail messages in dependence upon caller speech tags. And so on – showing that claim 13 in fact does not ‘read on’ claim 8 as asserted by the Office Action.

In addition, even if claim 13 did ‘substantially read on’ claim 8, such a ‘substantially read on’ would be insufficient for rejection of claims for obviousness under 35 U.S.C. § 103. The test for obviousness is *not* whether one claim substantially reads on another. The test for obviousness is whether references disclose *each and every element* of a claim. To establish a *prima facie* case of obviousness, the proposed combination of Akhteruzzaman and Hirschberg must teach or suggest all of Applicants’ claim limitations in claim 13.

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The Office Action does not cite the combination of Akhteruzzaman and Hirschberg for teaching *any* of the claim limitations of independent claim 13. The Office Action therefore cannot establish a *prima facie* case for obviousness under 35 U.S.C. § 103, and the rejection should be withdrawn.

In addition, even if the system for voicemail searching of claim 13 were similar to the system for voicemail searching in claim 8, which they are not, Applicants' responses to the rejection of claim 8 would apply to the rejection of claim 13. As discussed above, the combination of Akhteruzzaman and Hirschberg does not teach or suggest all of the limitations of claim 8. If, therefore, claim 13 did in fact 'substantially read on' claim 8 as asserted by the Office Action, then the combination of Akhteruzzaman and Hirschberg *could not possibly* teach or suggest all of the limitation of claim 13. Without more, the Office Action therefore cannot establish a *prima facie* case for obviousness under 35 U.S.C. § 103, and the rejection should be withdrawn.

The Combination Of Akhteruzzaman And Hirschberg  
Does Not Teach or Suggest All Claim Limitations Of Claim 14

The Office Action at page 5 rejects independent claim 14 stating that, "Claim 14 is rejected for the same reason stated above in Claims 8 rejection because the claim's means substantially read on the corresponding means of Claim 8." In response, Applicants respectfully note that independent claim 14 does not claim the same subject matter as independent claim 8. Claim 14 of the present invention claims:

14. A system for voicemail searching, the system comprising:

means for storing, in association with a voicemail message, message text converted from the voicemail message;

means for receiving, from a particular voicemail user, at least one search keyword; and

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means for selecting, in dependence upon the search keywords and the message text, one or more voicemail messages for the particular voicemail user.

The system for voicemail searching of claim 14 is different from the system for voicemail searching of claim 8. Claim 14 claims means for storing message text; claim 8 claims means for storing a voiceprint. Claim 14 claims means for selecting voicemail messages in dependence upon message text; claim 8 claims means for selecting voicemail messages in dependence upon caller speech tags. And so on – showing that claim 14 in fact does not ‘read on’ claim 8 as asserted by the Office Action.

In addition, even if claim 14 did ‘substantially read on’ claim 8, such a ‘substantially read on’ would be insufficient for rejection of claims for obviousness under 35 U.S.C. § 103. The test for obviousness is *not* whether one claim substantially reads on another. The test for obviousness is whether references disclose *each and every element* of a claim. To establish a prima facie case of obviousness, the proposed combination of Akhteruzzaman and Hirschberg must teach or suggest all of Applicants’ claim limitations in claim 14. The Office Action does not cite the combination of Akhteruzzaman and Hirschberg for teaching any of the claim limitations of independent claim 14. The Office Action therefore cannot establish a prima facie case for obviousness under 35 U.S.C. § 103, and the rejection should be withdrawn.

In addition, even if the system for voicemail searching of claim 14 were similar to the system for voicemail searching in claim 8, which they are not, Applicants’ responses to the rejection of claim 8 would apply to the rejection of claim 14. As discussed above, the combination of Akhteruzzaman and Hirschberg does not teach or suggest all of the limitations of claim 8. If, therefore, claim 14 did in fact ‘substantially read on’ claim 8 as asserted by the Office Action, then the combination of Akhteruzzaman and Hirschberg *could not possibly* teach or suggest all of the limitation of claim 14. Without more, the

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Office Action therefore cannot establish a prima facie case for obviousness under 35 U.S.C. § 103, and the rejection should be withdrawn.

No Suggestion To Modify Akhteruzzaman By Hirschberg

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Akhteruzzaman by Hirschberg. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion to modify Akhteruzzaman must come from the teaching of the references themselves, Akhteruzzaman or Hirschberg, and the Examiner must explicitly point to the teaching within one of the references suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "indsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 4 states its rationale for motivation to modify Akhteruzzaman by Hirschberg as:

[I]t would have been obvious to one of ordinary skill in the art to modify Akhteruzzaman's voiceprint based voice message screening system with voice message search engine based a key word text as taught by Hirschberg by transcribing received voice message into text and searching by the keyword text. One of ordinary skill in the art would have been motivated to do this to have a voice mail system, which allows a subscriber to search the messages in an efficient and intuitive manner without having to sequentially listen to each of the voicemail messages [Paragraph 0004] [Paragraph 0005, Line 1-4] [Paragraph 0003, Line 5-15].

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In response, Applicants respectfully note that the Office Action includes not one word pointing to anything anywhere in the references Akhteruzzaman or Hirschberg evidencing any suggestion or motivation to combine the references. What paragraph 0003 of Hirschberg actually teaches is that, "Current methods for accessing voicemail or more generally, recorded speech, require that the speech has to be stored and listened to in a sequential and serial manner." Paragraph 0004 of Hirschberg teaches "a voicemail system which allows a user to gist, search and browse through the messages in an efficient and intuitive manner" would improve the current art for accessing voicemail. Paragraph 0005 of Hirschberg teaches that the invention of Hirschberg improves the current art by providing "an automated voicemail processing system for gisting, browsing and searching through voicemail without having to sequentially listen to each of the voicemail messages." Nothing in paragraphs 0003, 0004, and 0005 suggests or motivates the modification of Akhteruzzaman by Hirschberg.

In addition, the motivation ascribed to 'one of ordinary skill' by the Office Action, that is, the motivation to "search the messages ... without having to sequentially listen to each of the voicemail messages ..." is *already disclosed in Hirschberg* – with no need or any possible motivation to combine references to achieve such message searching. Because the Office Action purports to point out a motivation to combine based on the knowledge of one of ordinary skill that in fact cannot possibly exist, the Office Action fails to point to any motivation to combine based on the knowledge of one of ordinary skill in the art at the time the present invention was made. Applicants already pointed out above that the Office Action points to nothing in the references themselves that would provide any motivation to combine. Without some reason given in the prior art or in the knowledge of persons of ordinary skill why anyone would have been prompted to combine the teachings of the references to arrive at the claimed invention, the proposed modification of Akhteruzzaman by Hirschberg cannot establish or support a *prima facie* case of obviousness, and the rejection should be withdrawn.

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No Reasonable Expectation Of Success In The  
Proposed Combination Of Akhteruzzaman And Hirschberg

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed modification of Akhteruzzaman by Hirschberg. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The present application claims methods, systems, and products for voicemail searching using caller speech tags, caller identification data, and message text. Akhteruzzaman teaches a speech analysis system that determines speech characteristics of a caller based on a portion of the voice message and stores speech characteristics of a caller with a calling party tag. Akhteruzzaman at paragraphs 0015 and 0017. Hirschberg teaches an extraction system that summarizes a voicemail. Hirschberg at paragraphs 0021 and 0022. The speech analysis system of Akhteruzzaman and the extraction system of Hirschberg cannot be combined so as to provide voicemail searching using caller speech tags, caller identification data, and message text as claimed in the present application. The proposed modification of Akhteruzzaman by Hirschberg therefore cannot support a *prima facie* case of obviousness. The rejections should be withdrawn and the case should be allowed.

Relation Among The Claims

Independent claim 8 claims system aspects of voicemail searching according to embodiments of the present invention. Independent claims 1 and 15 respectively claim method and computer program product aspects of voicemail searching according to embodiments of the present invention. Independent claim 8 is allowable for the reasons set forth above. Independent claims 1 and 15 are allowable because claim 8 is allowable. The rejections of claims 1 and 15 therefore should be withdrawn, and claims 1 and 15 should be allowed.

Independent claim 13 claims system aspects of voicemail searching according to embodiments of the present invention. Independent claims 6 and 19 respectively claim method and computer program product aspects of voicemail searching according to

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embodiments of the present invention. Independent claim 13 is allowable for the reasons set forth above. Independent claims 6 and 19 are allowable because claim 13 is allowable. The rejections of claims 6 and 19 therefore should be withdrawn, and claims 6 and 19 should be allowed.

Independent claim 14 claims system aspects of voicemail searching according to embodiments of the present invention. Independent claims 7 and 20 respectively claim method and computer program product aspects of voicemail searching according to embodiments of the present invention. Independent claim 14 is allowable for the reasons set forth above. Independent claims 7 and 20 are allowable because claim 14 is allowable. The rejections of claims 7 and 20 therefore should be withdrawn, and claims 7 and 20 should be allowed.

Claims 3-5 depend from independent claim 1. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Akhteruzzaman and Hirschberg does not teach or suggest each and every element of independent claim 1, so also the combination of Akhteruzzaman and Hirschberg cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 3-5 therefore should be withdrawn, and these claims also should be allowed.

Claims 10-12 depend from independent claim 8. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Akhteruzzaman and Hirschberg does not teach or suggest each and every element of independent claim 8, so also the combination of Akhteruzzaman and Hirschberg cannot possibly teach or suggest each and every element of any dependent claim. The rejections of claims 10-12 therefore should be withdrawn, and these claims also should be allowed.

Claims 17-18 depend from independent claim 15. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Akhteruzzaman and Hirschberg does not teach or suggest each and every element of independent claim 15, so also the combination of Akhteruzzaman and Hirschberg cannot

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possibly teach or suggest each and every element of any dependent claim. The rejections of claims 17-18 therefore should be withdrawn, and these claims also should be allowed.

Akhteruzzaman, Hirschberg, And Yuschik

Claims 2, 9, and 16 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1) further in view of Yuschik, *et al.* (U.S. Publication No. 20020152078A1). As will be shown below, the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik. The combination of Akhteruzzaman, Hirschberg, and Yuschik therefore does not establish a prima facie case of obviousness. The rejection of claims 2, 9, and 16 should therefore be withdrawn and the case should be allowed.

The Combination Of Akhteruzzaman, Hirschberg, And Yuschik

Does Not Teach or Suggest All Claim Limitations Of Claim 9

To establish a prima facie case of obviousness, the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik must disclose all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Claim 9 of the present application claims:

9. The system of claim 8 wherein means for storing a voiceprint further comprises means for prompting a caller for a predefined greeting for the voiceprint.

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The Office Action on page 7 relies on the combination of Akhteruzzaman and Hirschberg to teach all elements of claim 8 incorporated into dependent claim 9. As discussed above, the combination of Akhteruzzaman and Hirschberg does not teach the elements of claim 8 of the present application, either as listed in claim 8 or as incorporated into claim 9. Because the Office Action does not teach all the elements of independent claim 8, the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik cannot teach all of the limitations of claim 9 of the present application.

No Suggestion To Combine Akhteruzzaman,  
Hirschberg, And Yuschik

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Akhteruzzaman, Hirschberg, and Yuschik. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion to combine Akhteruzzaman, Hirschberg, and Yuschik must come from the teaching of the references themselves, Akhteruzzaman, Hirschberg, or Yuschik, and the Examiner must explicitly point to the teaching within one of the references suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at page 7 states its rationale for motivation to combine Akhteruzzaman, Hirschberg, and Yuschik as:

[I]t would have been obvious to one of ordinary skill in the art to further modify the storing of caller's voiceprint in Akhteruzzaman's voice-print based voice message screening system by allowing a calling party to leave the caller's name as taught by Yuschik's voiceprint identification system

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for efficiently identifying of calling party for retrieving the messages according to the caller's name [Figure 8] [Paragraph 53].

In response, Applicants respectfully note that the Office Action includes not one word pointing to anything anywhere in the references Akhteruzzaman, Hirschberg, or Yuschik evidencing any suggestion or motivation to combine the references. What Figure 8 of Yuschik as described in paragraph 0053 actually teaches is a system that "will play back each of the names spoken by the caller himself so that the subscriber can select which caller he desires 806." Nothing in paragraph 0053 suggests or motivates the combination of Akhteruzzaman, Hirschberg, and Yuschik.

In addition, the motivation ascribed to 'one of ordinary skill' by the Office Action, that is, the motivation for "identifying of calling party for retrieving the messages according to the caller's name ..." is *already disclosed in Yuschik* – with no need or any possible motivation to combine references to achieve such calling party identification. Because the Office Action purports to point out a motivation to combine based on the knowledge of one of ordinary skill that in fact cannot possibly exist, the Office Action fails to point to any motivation to combine based on the knowledge of one of ordinary skill in the art at the time the present invention was made. As discussed above, the Office Action points to nothing in the references themselves that would provide any motivation to combine. Without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention, the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik cannot establish a *prima facie* case of obviousness, and the rejection should be withdrawn.

No Reasonable Expectation Of Success In The Proposed Combination  
Of Akhteruzzaman, Hirschberg, And Yuschik

To establish a *prima facie* case of obviousness, there must be a reasonable expectation of success in the proposed combination of Akhteruzzaman, Hirschberg, and Yuschik. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The

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present application claims methods, systems, and products for voicemail searching using caller speech tags, caller identification data, and message text. Akhteruzzaman teaches a speech analysis system that determines speech characteristics of a caller based on a portion of the voice message and stores speech characteristics of a caller with a calling party tag. Akhteruzzaman at paragraphs 0015 and 0017. Hirschberg teaches extraction system that summarizes a voicemail. Hirschberg at paragraphs 0021 and 0022. Yuschkik teaches a voiceprint identification system that identifies and verifies a user. Yuschkik at Abstract. The speech analysis system of Akhteruzzaman, the extraction system of Hirschberg, and the voiceprint identification system of Yuschkik cannot be combined so as to provide voicemail searching using caller speech tags, caller identification data, and message text as claimed in the present application. The proposed combination of Akhteruzzaman, Hirschberg, and Yuschkik therefore cannot support a prima facie case of obviousness. The rejection should be withdrawn and the case should be allowed.

#### Relation Among The Claims

Claim 9 claims system aspects of voicemail searching according to embodiments of the present invention. Claims 2 and 16 respectively claim method and computer program product aspects of voicemail searching according to embodiments of the present invention. Claim 9 is allowable for the reasons set forth above. Claims 2 and 16 are allowable because claim 9 is allowable. The rejections of claims 2 and 16 therefore should be withdrawn, and claims 2 and 16 should be allowed.

#### Conclusion

Claims 1, 3-8, 10-15, and 17-20 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1). As explained above, the combination of Akhteruzzaman and Hirschberg does not establish a prima facie case of obviousness. The rejection of claims 1, 3-8, 10-15, and 17-20 should

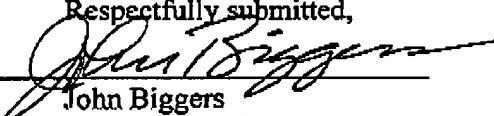
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therefore be withdrawn, and the claims should be allowed. Applicants request reconsideration of claims 1, 3-8, 10-15, and 17-20 in light of the present remarks.

Claims 2, 9, and 16 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Akhteruzzaman, *et al.* (U.S. Publication No. 20030169857A1) in view of Hirschberg, *et al.* (U.S. Publication No. 20030128820A1) further in view of Yuschik, *et al.* (U.S. Publication No. 20020152078A1). As explained above, the combination of Akhteruzzaman, Hirschberg, and Yuschik does not establish a prima facie case of obviousness. The rejection of claims 2, 9, and 16 should therefore be withdrawn, and the claims should be allowed. Applicants request reconsideration of claims 2, 9, and 16 in light of the present remarks.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

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